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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,200

03/12/2004

Sang-Ki Jeong

8054-32 (LW9063US)

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,200	<b>Applicant(s)</b> JEONG ET AL.	
	<b>Examiner</b> Timothy J. Kugel	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-13 and 32 are pending as amended on 12 May 2008, claims 14-31 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

### ***Response to Amendment and Arguments***

3. Applicant's amendment to claim 32, filed 12 May 2008, specifically correcting the spelling of 'ultraviolet', has been fully considered and overcomes the following:

The objection to claim 32 because of informalities has been withdrawn.

4. Applicant's amendment to claims 10, and 32, filed 12 May 2008, specifically including the essential element—the colored pigment—has been fully considered and overcomes the following:

The rejection of claims 10, 13 and 32 under 35 USC 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements, has been withdrawn.

5. Applicant's amendment to independent claims 1 and 32, filed 12 May 2008, specifically requiring the composition to comprise 12 to 18 weight percent solid powder, has been fully considered and overcomes the following:

The rejection of claims 1-4, 8 and 32 under 35 USC 102(b) as being anticipated by US 5,662,794 (Sato hereinafter) has been withdrawn.

The rejection of claims 7 and 9 under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Sato has been withdrawn.

The rejection of claims 1, 3, 4, 7, 8, 9 and 32 under 35 USC 102(b) as being anticipated by US 3,821,155 (Kloos hereinafter) has been withdrawn.

6. Applicant's arguments, filed 12 May 2008, have been fully considered but are not persuasive.

Applicant argues that the claimed range of solid powder is non-obvious, pointing to paragraph 29 of the published application as showing that the claimed range is critical to the viscosity of the composition and therefore the quality of the coating made; however, it is the examiner's position that the viscosity is dependent on not only the range of the solid powder present, but also the ratio of monomer to binder and the amount of solvent present and further such a relationship is not unexpected, still further since Kloos teaches the same viscosities as instantly claimed, one of ordinary skill in the art would expect the coating quality to be the same and would understand how to affect such through manipulation of the composition.

In response to applicant's argument that Kloos is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was

concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kloos is directed to a colored pigment composition which may be coated on a substrate which is reasonable pertinent to the particular problem with which the applicant is concerned and since Kloos explicitly teaches that the binder may be clear (Abstract), the composition is suitable for use in a filter for a display device as instantly claimed.

In regard to applicant's remarks concerning the fire retardant components of the Kloos composition, applicant's use of the term 'comprising' is inclusive or open-ended and does not exclude additional, unrecited elements or method steps such as the fire retardants of Kloos.

### ***Claim Rejections - 35 USC § 103***

7. Claims 1-13 and 32 are rejected under 35 USC § 103(a) as being unpatentable over US Patent 3,821,155 (Kloos hereinafter).

Kloos teaches compositions coated to a substrate (Abstract and Column 1 Lines 51-54) having viscosities of less than 10,000 cps at 25°C (Column 4 Lines 10-19) comprising 5-20 parts by weight of a curable film forming binder (Column 1 Lines 7-9) that comprises a mixture of monomers (Column 5 Lines 30-45) which, as they cure would form the mixture of binder and monomer instantly claimed; 95-70 parts by weight of 35 to 70 weight percent sand coated with a curable epoxy resin and 25 to 50 weight percent black, red, blue or green pigments or mixtures thereof (Column 1 Lines 33-50, Column 2 Lines 14-45 and Column 4 Lines 42-48) wherein the pigments are dispersed

into suitable vehicles such as dibutyl phthalate—which reads on the solvent instantly claimed—and a surfactant—which would act as a dispersant (Column 4 Lines 49-60).

Regarding the limitation “for a display device”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the Kloos composition is capable of performing the intended use as Kloos explicitly teaches that the binder is clear (Abstract), it meets the claim.

While Kloos does not disclose expressly the ratio of the binder to monomer instantly claimed, as the monomers of the binder cured to solid polymer, one of ordinary skill in the art at the time the invention was made would have understood that all ratios—from 100% monomer to 100% polymer—would occur.

Further, while Kloos does not disclose expressly the percentage of solid powder—coated sand—in the binder or the percentage of pigment in the powder as instantly claimed, it would have been obvious to one of ordinary skill in the art at the time the invention was made that such percentages could be manipulated to achieve the predictable results of increasing or decreasing the intensity of the color in the composition.

It has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a *prima facie* rejection is properly established when the difference in the range or value is minor. See *Titanium Metals Corp of Am v. Banner*, 778 F2d 775, 783, 227 USPQ 773, 779 (Fed Cir 1985).

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See *In re Boesch*, 617 F2d 272, 205 USPQ 215 (CCPA 1980). See *In re Aller*, 220 F2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). See *In re Hoeschele*, 406 F2d 1403, 160 USPQ 809 (CCPA 1969).

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571)

272-1460. The examiner can normally be reached on 6:00 AM - 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/  
Patent Examiner, AU 1796